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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,171	09/30/2003	Rinaldo Caprotti	2002M013	5909
7590 Infineum USA L.P. Law Department 1900 East Linden Avenue P.O. Box 710 Linden, NJ 07036-0710		12/13/2007	EXAMINER TOOMER, CEPHIA D	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,171	Applicant(s) CAPROTTI ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed October 3, 2007 in which claim 6 was amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krull (US 6,610,111).

Krull teaches a low-temperature stabilized additive for fuel oils having a sulfur content of up to 0.05% (500 ppm) comprising A1) 1-99% by weight of at least one saturated monocarboxylic acid having 6-50 carbon atoms and A2) from 1-99% by weight of at least one unsaturated monocarboxylic acid having from 6 to 50 carbon atoms (see abstracts). Constituent A2) may contain one or more double bonds and the proportions of A1) is less than 10% (see col. 3, lines 40-48). The fuel additive can be combined with antioxidants or conductivity improvers (see col. 17, lines 7-15). The additives are added to the fuel in a solvent/carrier solution (see col. 15, lines 6-14). The fuel may be a middle distillate or jet fuel (see col. 16, lines 54-61).

Krull teaches the limitations of the claims other than that he does not specifically teach a composition wherein a plurality of salts of monocarboxylic acids are present.

However, it would have been obvious to one of ordinary skill in the art to use a plurality of the salts of these acids because Krull teaches that at least one acid is used and the language "at least one" suggests that a plurality may be present in the composition.

With respect to the limitation regarding the salts of the acids, it is well settled that a reference that recites an acid renders obvious the salt of the acid where both the acid and its salt function similarly. *Merck v. Teva* 347 F. 3d 1367 (Fed. Cir. 2003) and *Glaxo v. Quigg* 13 USPQ2d 1628 (Fed. Cir. 1990).

3. Applicant's arguments have been fully considered but they are not persuasive.

Applicant's main argument is that Krull teaches additives comprising fatty acid mixtures and that there is no teaching of an additive composition comprising salt derivatives of the acids. Applicant argues that the examiner has trivialized the present invention by suggesting that it would have been obvious to use a salt of the acids taught by Krull. Applicant sets forth reasons why the acids of Krull do not suggest the claimed salts and Applicant argues that there is no reasonable expectation of success when using the acids.

It is well settled that salts of carboxylic acids are rendered obvious by their acids. Carboxylic acids and salts having hydrocarbon chains longer than six carbons both exhibit unusual behavior in water due to the presence of both hydrophilic (CO₂) and hydrophobic (hydrocarbon chain) regions in the same molecule. Therefore, since the acids of Krull are used in the same environment as the salts of the present invention, one skilled in the art would expect that these acid compounds would function in a manner similar to that of the salts, in the absence evidence to the contrary. Applicant's

discovery of the claimed salts would have been obvious in view of the nature of the compounds.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cepha D. Toomer
Primary Examiner
Art Unit 1797

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